

II. REMARKS

A. Introduction

The Office Action dated January 22, 1998 has been carefully reviewed and the foregoing amendments made in response thereto.

Claims 2, 3, 5, 8-12, 14, 15, 17-24, 26, 28, 30, 31, 33, 36, and 38 are amended. Claims 2-15 and 17-39 are pending in the application.

Claims 2-15 and 17-39 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claims 2-8, 19-27, 33, and 34 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Claim 12 stands rejected under 35 U.S.C. § 102 (b) as being anticipated by "Telesoftware-Valued Added Teletext," by Hedger et al. (hereinafter Hedger).

Claims 5-8 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over "A Public Broadcaster's View of Teletext in the United States," by Hartford Gunn. (hereinafter Gunn).

Claims 2-15 and 17-39 remain active in this application. No new matter is presented in the foregoing amendments. Approval and entry of same is respectfully requested.

B. Response to Requirement Imposed Upon Applicants to Resolve Alleged Conflicts Between Applicants' Applications.

Applicants respectfully traverse the requirements of the Office Action paragraph 5.

Paragraph 5 of the Office Action requires Applicants to either:

- (1) file terminal disclaimers in each of the related 328 applications terminally disclaiming each of the other 327 applications; or
- (2) provide an affidavit attesting to the fact that all claims in the 328 applications have been reviewed by applicant and that no conflicting claims exist between the applications; or
- (3) resolve all conflicts between claims in the related 328 applications by identifying how all the claims in the instant application are distinct and separate inventions from all the claims in the above identified 328 applications.

In addition, Examiner states that failure to comply with any one of these requirements will result in abandonment of the application.

Examiner states that the requirement has been made because conflicts exist between claims of the related co-pending applications, including the present application. Examiner sets forth only the serial numbers of the co-pending applications without an indication of which claims are conflicting. Examiner has also attached an Appendix providing what is deemed to be clear evidence that conflicting claims exist between the 328 related co-pending applications and the present application. Further, Examiner states that an analysis of all claims in the 328 related co-pending applications would be an extreme burden on the Office requiring millions of claim comparisons.

Applicants respectfully traverse these requirements in that Examiner has both improperly imposed the requirements, and has incorrectly indicated that abandonment will occur upon failure to comply with the requirement. Applicants' traversal is supported by the fact that 37 C.F.R. § 1.78 (b) does not, under the present circumstances, provide Examiner with authority to require Applicants to either: 1) file terminal disclaimers; 2) file an affidavit; or 3) resolve all apparent conflicts. Additionally, the penalty of abandonment of the instant application for failure to comply with the aforementioned requirement is improper for being outside the legitimate authority to impose abandonment upon an application. The following remarks in Section (B) will explain Applicants' basis for this traversal.

1. The PTO's New Requirement is an Unlawfully Promulgated Substantive Rule Outside the Commissioner's Statutory Grant of Power

The PTO Commissioner obtains his statutory rulemaking authority from the Congress through the provisions of Title 35 of the United States Code. The broadest grant of rulemaking authority -- 35 U.S.C. § 6 (a) -- permits the Commissioner to promulgate regulations directed only to "the conduct of proceedings in the [PTO]". This provision does NOT grant the Commissioner authority to issue substantive rules of patent law. Animal Legal Defense Fund v. Quigg, 932 F.2d 920, 930, 18 USPQ2d 1677, 1686 (Fed. Cir. 1991).¹ Applicants respectfully submit that the Examiner's creation of a new set of requirements based upon 37 CFR § 1.78(b) constitutes an unlawful promulgation of a substantive rule in direct contradiction of a long-established statutory and regulatory scheme.

2. The PTO's Requirement is a Substantive Rule

The first determination is whether the requirement as imposed by the PTO upon Applicants is substantive or a procedural rule. The Administrative Procedure Act offers general guidelines under which all administrative agencies must operate. A fundamental premise of administrative law is that administrative agencies must act solely within their statutory grant of power. *Chevron v. Natural Resources Defense Council*, 467 U.S. 837 (1984). The PTO Commissioner has NOT been granted power to promulgate substantive rules of patent law. *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543 (Fed. Cir. 1996), citing, *Animal Legal Defense Fund v. Quigg*, 932 F.2d 920, 930, 18 USPQ2d 1677, 1686 (Fed. Cir. 1991).

The appropriate test for such a determination is an assessment of the rule's impact on the Applicants' rights and interests under the patent laws. *Fressola v. Manbeck*, 36 USPQ2d 1211, 1215 (D.D.C. 1995). As the PTO Commissioner has no power to promulgate substantive rules,

¹ Accord *Hoechst Aktiengesellschaft v. Quigg*, 917 F.2d 522, 526, 16 USPQ2d 1549, 1552 (Fed. Cir. 1990); *Glaxo Operations UK Ltd. v. Quigg*, 894 F.2d 392, 398-99, 13 USPQ2d 1628, 1632-33 (Fed. Cir. 1990); *Ethicon Inc. v. Quigg*, 849 F.2d 1422, 1425, 7 USPQ2d 1152, 1154 (Fed. Cir. 1988).

the Commissioner receives no deference in his interpretation of the statutes and laws that give rise to the instant requirement. *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543 (Fed. Cir. 1996), citing, *Chevron v. Natural Resources Defense Council*, 467 U.S. 837 (1984). When agency rules either (a) depart from existing practice or (b) impact the substantive rights and interests of the effected party, the rule must be considered substantive. *Nat'l Ass'n of Home Health Agencies v. Scheiker*, 690 F.2d 932, 949 (D.C. Cir. 1982), *cert. denied*, 459 U.S. 1205 (1983).

a. The PTO Requirement is Substantive Because it Radically Changes Long Existing Patent Practice by Creating a New Requirement Upon Applicants Outside the Scope of 37 C.F.R. § 1.78 (b)

The Examiner's requirement is totally distinguishable from the well articulated requirement authorized by 37 CFR § 1.78 (b), because it (1) creates and imposes a new requirement to avoid abandonment of the application based on the allegation that conflicts exist between claims of the related 328 co-pending applications, and (2) it results in an effective double patenting rejection without the PTO's affirmative double patenting rejection of the claims. Long existing patent practice recognizes only two types of double patenting, double patenting based on 35 U.S.C. § 101 (statutory double patenting) and double patenting analogous to 35 U.S.C. § 103 (the well-known obviousness type double patenting).² These two well established types of double patenting use an objective standard to determine when they are appropriate³ and have a determinable result on the allowability of the pending claims.

²MPEP § 804(B)(1) states, in an admittedly awkward fashion, that the inquiry for obviousness type double patenting is analogous to a rejection under 35 U.S.C. 103: "since the analysis employed in an obvious-type double patenting determination parallels the guidelines for a 35 U.S.C. 103 rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis".

³ The objective test for same invention double patenting is whether one of the claims being compared could be literally infringed without literally infringing the other. The objective test for obviousness type double patenting is the same as the objective nonobviousness requirement of patentability with the difference that the disclosure of the first patent may not be used as prior art.

The Examiner's new requirement represents a radical departure from long existing patent practice relevant to conflicting claims between co-pending applications of the same inventive entity. Two well established double patenting standards are based on an objective analysis of comparing pending and *allowed* claims. However, in the present application, there are no *allowed* claims. The Examiner's new requirement to avoid a double patenting rejection presumes that conflicts exist between claims in the present application and claims in the 327 copending applications. This presumption of conflicts between claims represents a radical departure from long existing patent practice as defined by 37 C.F.R. § 1.78 (b), which states:

Where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

Clearly, the only requirement authorized by the rule is the elimination of conflicting claims from all but one application where conflicting claims have been determined to exist. Furthermore, in order to determine that conflicting claims do in fact exist in multiple applications, the only possible analysis is obviousness-type double patenting, since there are no allowed or issued claims by which to employ the 35 U.S.C. § 101 statutory double patenting analysis. Once obviousness-type double patenting analysis has been applied and conflicting claims have been determined to exist, only a *provisional* obviousness-type double patenting rejection is possible until claims from one application are allowed.

In summary, the Examiner's new requirement departs from long-established practice because it (1) creates and imposes a new requirement to avoid abandonment of the application based on the allegation that conflicts exist between claims of the related 328 co-pending applications, and (2) it results in an effective double patenting rejection without the PTO's affirmative double patenting rejection of the claims.

Therefore, the Examiner's new requirement departs from existing practice and therefore is a substantive rule beyond the authority of the PTO and is therefore, invalid.

**b. The New Requirement is Also a Substantive Rule
Because it Adversely Impacts the Rights and
Interests of Applicants to Benefits of the Patent**

The rights and benefits of a U.S. patent is solely a statutory right. *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543 (Fed. Cir. 1996). The essential statutory right in a patent is the right to exclude others from making, using and selling the claimed invention during the term of the patent. Courts have recognized that sometimes new procedural rules of the PTO are actually substantive rules, e.g. when the new rule made a substantive difference in the ability of the applicant to claim his discovery. *Fressola v. Manbeck*, 36 USPQ2d 1211, 1214 (D.D.C. 1995) (emphasis added), citing, *In re Pilkington*, 411 F.2d 1345, 1349; 162 USPQ 145 (CCPA 1969); and *In re Steppan*, 394 F.2d 1013, 1019; 156 USPQ 143 (CCPA 1967).

The new requirement, on its face and as applied here, is an instance of a PTO rule making a substantive difference in Applicants' ability to claim their invention and, therefore, must be considered a substantive rule. The requirement denies Applicants rights and benefits expressly conferred by the patent statute. The measure of the value of these denied rights and benefits is that the requirement, as applied here, would deny Applicants the full and complete PTO examination of Applicants' claims on their merits, as specified by 37 C.F.R. § 1.105. In addition, to file terminal disclaimers in each of the related 328 applications terminally disclaiming each of the other 327 applications based on the PTO's incomplete examination on the merits would deny Applicants the benefit of the full patent term of 17 years on each of Applicants' respective applications. Applicants respectfully submit that the requirement has a huge impact on their rights and interests in the presently claimed invention.

c. Conclusion: Substantive Rule

In summary, the requirement is a change to long existing practice and/or has a substantive impact on the rights and interests of Applicants to their invention. Either finding means that the new requirement is a substantive rule. Since the Commissioner has no power to issue

substantive rules, the requirement is an improperly promulgated substantive rule having no force of law.

3. The PTO Requirement is Outside the Scope of 37 C.F.R. § 1.78 (b)

Rule 78 (b) states that:

Where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

The only **requirement** that Rule 78 (b) authorizes is the elimination of conflicting claims from all but one co-pending applications.

In the instant Office Action, Examiner has not required the elimination of all conflicting claims from all but one application, but instead has required Applicants to: 1) file terminal disclaimers in each of the related 328 applications; 2) provide an affidavit; or 3) resolve all conflicts between claims in the related 328 applications. None of the options in the requirement is authorized by Rule 78 (b), and therefore Applicants respectfully submit that such a requirement is improper.

With respect to the PTO's authority to act within Rule 78 (b) regarding the rejection of conflicting claims, MPEP § 822.01 states that:

Under 37 CFR § 1.78 (b), the practice relative to overlapping claims in applications copending before the examiner..., is as follows: Where claims in one application are unpatentable over claims of another application of the same inventive entity because they recite the same invention, *a complete examination should be made of the claims of each application* and all appropriate rejections should be entered in each application, including rejections based upon prior art. *The claims of each application may also be rejected on the grounds of provisional double patenting on the claims of the other application* whether or not any claims avoid the prior art. Where appropriate, the same prior art may be relied upon in each of the applications. MPEP 822.01 (6th Ed., Rev. 3, 1997), (*emphasis added*).

In light of the requirement of the Office Action, MPEP § 822.01 and 37 CFR § 1.78 (b) are not applicable since there has not been any rejection with regard to the elimination of conflicting claims from all but one co-pending application.

4. The Assertion That Failure to Comply with the Requirement Will Result in Abandonment of Applicants' Application is Improper

Applicants' prospective failure to comply with the above requirements cannot properly result in abandonment of the present application. Applicants respectfully submit that abandonment of an application can properly occur only:

- (1) for failure to respond within a provided time period (under Rule 135);
- (2) as an express abandonment (under Rule 138); or
- (3) the result of failing to timely pay the issue fee (under Rule 316).

There is no provision in the rules permitting abandonment for failure to comply with any of the presented requirements. To impose an improper requirement upon Applicants and then hold the application is to be abandoned for failure to comply with the improper requirement violates the rules of practice before the USPTO. Furthermore, Examiner is in effect attempting to create a substantive rule which is above and beyond the rulemaking authority of the USPTO, and therefore is invalid.

In the *Application of Mott*, 539 F.2d 1291, 190 USPQ 536 (CCPA 1976), the applicant had conflicting claims in multiple applications. The CCPA held that action by the Examiner which would result in automatic abandonment of the application was legally untenable. *Id.* at 1296, 190 USPQ at 541. In the present application, Examiner has asserted that there are conflicting claims in multiple applications, and that non-compliance of the Office Action's requirement will result in an automatic abandonment. Therefore, under *Mott's* analysis, the Office Action's result of abandonment of Applicants' application is legally untenable.

5. Response to Apparent Conflict of Claims

Applicants submit that the presentation of the Office Action Appendix fails to demonstrate any conflicts between claims of the present application and claims of the co-pending applications. Rather, the Office Action Appendix compares representative claims of *other* applications in attempt to establish that "conflicting claims exist between the 328 related co-

pending applications.” Absent any evidence of conflicting claims between the Applicants’ present application and any other of Applicants’ co-pending applications, any requirement imposed upon Applicants to resolve such alleged conflicts is improper.

6. Request for Withdrawal of Requirement

Therefore, Applicants respectfully request that Examiner reconsider and withdraw the requirement that Applicants: (1) file terminal disclaimers in each of the related 328 applications terminally disclaiming each of the other 327 applications; (2) provide an affidavit attesting to the fact that all claims in the 328 applications have been reviewed by applicant and that no conflicting claims exist between the applications; or (3) resolve all conflicts between claims in the above identified 328 applications by identifying how all the claims in the instant application are distinct and separate inventions from all the claims in the above identified 328 applications, which upon failing to do so will abandon the application.

7. Filing of Supplemental Oath

Notwithstanding the foregoing, Applicants will file a supplemental oath under 37 C.F.R. § 1.67 for each application when Examiner identifies allowable subject matter. Applicants respectfully propose that the filing of individual supplemental oaths attesting to the absence of claim conflicts between previously patented claims and subsequently allowed claims is a more reasonable method of ensuring the patentable distinctness of subsequently allowed claims.

Under 37 C.F.R. § 1.105, § 1.106 & § 1.78 (b), Examiner has the duty to make every applicable rejection, including double patenting rejection. Failure to make every proper rejection denies Applicants all rights and benefits related thereto, e.g., Applicants’ right to appeal, etc. Once obviousness-type double patenting analysis has been applied and conflicting claims have been determined to exist, only a *provisional* obviousness-type double patenting rejection is possible until claims from one application are allowed.

C. Information Disclosure Statement

The Applicants appreciate the Examiner's review of the Information Disclosure Statements filed 9/8/95, 12/11/95, 12/22/95, 2/6/96, and 4/7/97 and have addressed those specific concerns raised in paragraph 6 of the Office Action. It is the Applicants' understanding that the Examiner raised the following 5 issues:

- (1) the reasons for such a large number of references cited,
- (2) foreign language references cited without a statement of relevance or translation have not been considered,
- (3) the relevancy of numerous references listed in the Information Disclosure Statements are subsequent to the Applicants' latest effective filing date,
- (4) citation of references apparently unrelated to the subject matter of the claimed invention, and
- (5) citation of database search results listed in foreign languages where no copy was provided.

1. Reason for Citation of Large Number of References

The reason that the Applicants submitted such a large number of references in the Information Disclosure Statements was that a large portion of the information cited by the Applicants was brought to the Applicants' attention in the discovery processes in a previous litigation in the United States District Court for the Eastern District of Virginia (*Personalized Mass Media Corp. v. The Weather Channel, Inc.* Docket No. 2:95 cv 242) and an investigation by the International Trade Commission (*In the Matter of Certain Digital Satellite System (DSS) Receivers And Components Thereof*, No. 337 TA 392, which was direct to U.S. Pat. No. 5,335,277) regarding claims in the Applicants' related issued patents. The documents listed in the Information Disclosure Statement were cited during the previous litigation/investigative proceedings by the alleged infringers in the aforementioned proceedings as being relevant and material to patentability of the claims in the related patents. The Applicants submitted those materials in the Information Disclosure Statement to the PTO at the earliest possible time in

order to file them in compliance with the 3 month requirement stated in the certification used to submit the Information Disclosure Statement before the Office Action was issued as is necessary under 37 CFR § 1.97 (c) (1). In such haste, entries were inadvertently submitted which do not appear on their face to be material to the patentability of the present application. Applicants have corrected this error with the submission of the corrected Information Disclosure Statement as shown in Appendix B. However, it is the Applicants' understanding that not all references cited must be material to patentability in order for such references to be considered. In § 609 of the MPEP, it states,

“[t]hese individuals also may want the Office to consider information for a variety of reasons: e.g., without first determining whether the information meets any particular standard of materiality, or because another patent office considered the information to be relevant in a counterpart or related patent application filed in another country, or to make sure that the examiner has an opportunity to consider the same information that was considered by the individuals that were substantially involved in the preparation or prosecution of a patent application.”

Applicants' position is that information that was considered material in previous litigation would fall into the 'variety of reasons' category as stated above. Applicants intention was not to confuse or make difficult the examination process for the Examiner, but was instead to be forthright and open in disclosing all information deemed to be relevant to the application in issue by third parties.

2. Citations of Foreign Language References

Applicants have re-examined the foreign references listed in all of the Information Disclosure Statements and have either eliminated such references from the list, included translations herewith or provided statements as to the relevancy of such references (APPENDIX A). The inclusion of translations with this response is in compliance with 37 C.F.R. § 1.97 (f) which states in part, “[I]f a bona fide attempt is made to comply with 37 C.F.R. § 1.98, but part of the required content is inadvertently omitted, additional time may be given to enable full compliance.” The omission of any translations and/or relevancy statements for foreign

references were inadvertent and unintentional and are herein submitted in accordance with 37 C.F.R. § 1.97 (f).

**3. References in the Information Disclosure Statements
Subsequent to Applicants' Latest Effective Filing Date
of 9/11/87**

Examiner stated "[n]umerous references listed in the IDS are subsequent to the applicant's latest effective filing date of 9/11/87, therefore, the relevancy of those references is unclear." Upon further examination, the Applicants have eliminated those patents and publications after the effective filing date for the present application. It is the Applicants' understanding that the effective filing date for the present application is 11/3/81.

4. Citation of Unrelated References

Applicants appreciate the Examiner pointing out such references that were listed yet on their face appear to be unrelated to the subject matter of the present application. In response to such information, the Applicants have reviewed the cited references and removed any such references which appear to be unrelated on their face to the claimed subject matter such as the patent for a beehive, the patent for a chemical compound and numerous computer printout search results.

5. Citation of Database Search Results

Database search results listed in foreign languages where no copy was provided have been eliminated from the substitute Information Disclosure Statement included with this office action.

The Applicants offer the corrected Information Disclosure Statement (APPENDIX B) as a substitute to the previously filed Information Disclosure Statement filed 4/7/97. No new entries have been entered, only citations which have, upon further examination, been determined not to be relevant to the claimed subject matter have been eliminated, typographical errors have been corrected, dates inserted where possible and the list shortened as a result. It is the Applicants'

intention that such corrected Information Disclosure Statement will help clarify any issues previously raised by the Examiner and aid in the prosecution of the present patent application.

D. Response to Rejections under 35 U.S.C. § 112

1. Specification Support of Claims 2-15 and 17-38

Paragraph 7 of the Office Action rejects claims 2-15 and 17-38 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The following tables list Applicants' claim language in the left column which corresponds to the specification support in the right column.

a. Claim 2

receiving [some] information content, <u>at least one</u> [or more] control signal[s in] <u>with respect</u> [of] <u>to</u> a budget , and said at least one of a broadcast and a cablecast transmission, said information content and said <u>at least one</u> [or more] control signal[s] including a first projected datum, said first projected datum [both] designating a product or service and projecting a price or quantity	For example, page 539 lines 7-11 with page 548 lines 12-16. Page 548 lines 1-5 (and page 552 lines 14-15), page 550 lines 30-32. Page 550 lines 9-14 Page 543 line 33 to page 544 line 3. Page 544 lines 1-3.
storing said first projected datum in said computer	Page 548 lines 1-4, page 24 lines 14-16, page 550 lines 9-11.
generating budget data by processing data stored in said computer in response to <u>said</u> at least one [of said] control signal[s]	Page 548 lines 18-22, page 550 lines 30-31, page 549 line 32 to page 550 line 10.
said budget data including <u>at least</u> two [or more] of [a group of data including]:	
(1) an income datum	Page 550 line 32.
(2) an expense datum	Page 550 line 32.
(3) a profit datum	Page 550 line 32
outputting to a subscriber at least [some] <u>a portion</u> of said	Page 548 lines 11-17 and page 552 lines 14-30, including "in the fashion of example #10" at page 552 line 20.

information content and at least one [generated] of said budget data[um], wherein said information content explains[ing] at least a portion of receiver specific budget containing said budget data[um].	<p>Page 552 lines 24-26</p> <p>Page 552 lines 26-30. For example, page 504 lines 10-11, page 555 line 3 and page 555 line 28. For example, page 491 lines 10-16. For example, page 491 lines 34-35, page 492 line 30, and page 493 lines 20-21.</p>
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b. Claim 3

said resource data including at least two [or more] of [a group of datum including]: (a) an equipment or real estate datum	Page 534 lines 12 and 7-8.
(b) a labor datum	Page 556 line 29.
(c) a financial datum	Page 534 line 13.

c. Claim 4

programming said computer to respond to said broadcast or cablecast control signal in respect of said budget	Page 537 lines 10-17 with respect to page 548 lines 1-6 (e.g., page 484 lines 15-17). Page 548 lines 18-22 and page 550 lines 30-32.
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d. Claim 5

receiving at a transmitter station [some] code which is effective at a receiver station to generate and output user specific budget data	Page 547 lines 19-26 and page 552 lines 8-10 with page 364 line 25 to page 365 line 8 or page 54 lines 2-6, page 548 lines 18-22, page 552 lines 30-32, page 552 lines 24-30.
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e. Claim 9

receiving said at least one instruct signal to be transmitted by the remote intermediate [data] transmitter station and delivering said at least one instruct signal to [a] said at least one origination transmitter, said at least one instruct signal being effective at said at least one receiver station to generate and output user specific budget data;	<p>Page 542 lines 5-10, page 20 line 4, page 101 line 6, page 451 lines 7-9, page 539 lines 7-11/</p> <p>Page 542 lines 5-10</p> <p>For example, page 542 line 26.</p> <p>Page 548 lines 18-22, page 552 lines 30-32, page 552 lines 24-30.</p>
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f. Claim 12

generating and outputting user specific budget data on the basis of	Page 548 lines 18-22, page 552 lines 30-32, page 552 lines 24-30.
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information received from said processor	Page 161 lines 21-23 with page 552 line 11.
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g. Claim 17

performing at least one of formulating and assembling in said network a signal effective at said interactive mass medium program output apparatus to generate and output user specific budget data	Page 545 lines 6-28 with page 42 lines 8-11, page 363 line 25 to page 365 line 8, page 14 lines 24-25, page 24 lines 19-21, page 54 lines 1-8. Page 548 lines 18-22, page 552 lines 30-32 Page 552 lines 24-30.
delivering combined medium programming that explains a user specific budget at said output device on the basis of said signal	Page 552 lines 15-30. Page 40 lines 17-25, page 59 lines 29-31, page 548 lines 1-2, an page 552 line 14.

h. Claim 18

wherein said information content includes mass medium programming[, said mass medium programming] of a duration, <u>and wherein only a portion</u> [some] of said duration [containing] <u>contains</u> a time interval of specific relevance,	Page 552 lines 20-30, including "in the fashion of example #10" at line 20, with page 478 lines 25-26 through page 509 lines 31-32 and page 344 lines 27-29. Page 27 lines 21-33.
outputting said mass medium programming at said receiver station	Page 552 lines 16-19 with page 541 lines 5-11, page 542 lines 6-9 and page 543 lines 5-9 with, for example page 2 lines 8-19.
outputting <u>one of</u> said budget data[um] in said time interval	Page 552 lines 26-30 with page 552 line 20 and for example page 492 lines 23-30 with page 493 lines 16-21.

i. Claim 19

prompting said subscriber [via] <u>in</u> said video for data input, said data input to serve as a basis for a budget	Page 14 lines 24-25, page 24 line 19-21, and page 37 line 22 to page 38 line 10.
assembling in said network, a plurality of budgeting instructions, said plurality of budgeting instruction operative at said interactive video output apparatus to formulate [a] <u>said</u> budget; and	Page 14 lines 24-25, page 24 line 19-21, and page 37 line 22 to page 38 line 10. Page 54 lines 1-8. Page 548 lines 18-22, page 549 line 32 to page 550 line 10, page 550 lines 30-32.
delivering said budget [to] <u>at</u> said interactive video output apparatus	Page 551 lines 11-14.

j. Claim 20

said <u>at least</u> one [or more] remote station[s] is capable of generating higher language code, said higher language code being contained in said plurality of budgeting instructions	Page 379 lines 5-19 and lines 26-27 with page 364 lines 9-15. Page 545 lines 9-10 and lines 27-28 with page 548 lines 3-4.
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k. Claim 24

processing said input data to serve as a basis for generating one or more of said plurality of budgeting instructions	Page 555 line 30 to page 556 line 14 with page 545 lines 3-11, including "in the fashion in example #10" at lines 8-9, page 379 lines 5-19 and page 363 line 34 to page 364 line 1.
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l. Claim 25

wherein formulating said budget comprises the steps of: outputting video, audio or hardcopy	Formulate. 3. To devise: invent < <i>formulate</i> new strategy>. Webster's II New College Dictionary 440 (1995). Page 552 lines 20-30, including "in the fashion of example #10" at line 20. Page 490 lines 19-23, page 496 lines 12-28.
computing a value in accordance with generally applicable output information content; and	Page 486 lines 16-17, page 485 lines 14-15, page 358 lines 1-9 and page 364 lines 9-22 with respect to page 486 line 14.
[presenting] <u>producing</u> said value within said video, audio or hardcopy	Page 491 lines 13-16 with page 486 line 25, page 492 lines 23-30, and page 496 line 26.

m. Claim 28

An interactive method for delivering a budget for use with an interactive mass medium programming output apparatus, said interactive mass medium programming output apparatus having an input device for receiving input from a subscriber, a memory for storing data, a processor for processing said subscriber reply, a transmitter for transmitting information to <u>at least</u> one [or more] remote station[s], and a receiver for receiving a signal from said one or more remote stations, said interactive mass medium output apparatus and	Page 538 line 18. Page 538 line 18 and page 534 line 104, Fig. 7. # 225 in Fig. 7 or page 23 line 23 #256 in Fig. 7, page 534 line 6-7 or page 551 lines 11-14. #200 in Fig. 7 or #205 #200 in Fig. 7, 22 in Fig. 2 #222 in Fig. 7
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said <u>at least one</u> [or more] remote station[s] comprising a network having a plurality of transmitter devices, said network being capable of delivering combined medium programming that explains a user specific budget at said output device on the basis of said signal <u>one of</u> generating and assembling at least [some] a <u>portion</u> of a message stream based [upon the] <u>on said</u> data, said message stream [operable] <u>operative</u> at said interactive mass medium programming output apparatus to deliver generally applicable output information content and <u>at least one</u> [or more] instruct signal[s] which formulates budget output, the method comprising the steps of:	<p>page 536 line 17 with line 26. #92 in Fig. 6B, #20 in Fig. 7.</p> <p>Page 543 lines 3-11, page 547 lines 19-26, page 14 lines 24-25, page 24 lines 15-21, page 59 lines 20-23, page 555 line 30 to page 556 line 18, page 548 lines 1-2, page 555 lines 8-9.</p> <p>Page 552 lines 19-30, page 357 lines 23-35.</p> <p>Page 20 line 4, page 101 line 6, page 451 lines 7-9, page 548 lines 18-22, page 549 line 32 to page 550 line 10, page 550 lines 30-32.</p>
outputting mass medium programming	Page 543 lines 7-11 with page 543 lines 5-10 with, for example, page 543 line 17 or page 552 line 20.
prompting said subscriber during said mass medium programming for input [in] <u>with</u> respect [of] <u>to</u> said budget	Page 538 line 18 with page 533 lines 24-31 and in example #10, page 471 line 6-13.
receiving a reply from said subscriber at said input device in response to said prompting	Page 471 lines 14-21, page 555 lines 14-19.
processing said reply and <u>selecting</u> said data [from] <u>based on</u> said step of receiving [said reply and selecting said data];	Page 555 lines 19-27.
communicating said selected data to <u>said</u> at least one [of said one or more] remote station[s]; and	Page 555 line 26 to page 556 line 11.
delivering said budget output	Page 556 lines 12-18 with page 551 lines 11-14 or page 552 lines 20-3.

n. Claim 32

outputting video, audio or hardcopy	Page 490 lines 19-23, page 496 lines 12-28
computing a value in accordance	Page 486 lines 16-17, page 485 lines 14-15, page 358 lines

with said [selected and transmitted] generally applicable output information content	1-9 and page 364 lines 9-22 with respect to page 486 line 14.
delivering said value in said outputted video, audio or hardcopy	Page 491 lines 13-16 with page 486 line 25, page 492 lines 23-30, and page 496 line 26.

o. Claim 33

wherein said interactive mass medium programming output apparatus[,] outputs mass medium programming of a duration, <u>only a portion of said duration</u> including a time interval of specific relevance,	Page 552 lines 20-30, including "in the fashion of example #10" at line 20, with page 478 lines 25-26 through page 509 lines 31-32 and page 344 lines 27-29. Page 27 lines 21-33.
said method further comprising the step of outputting subscriber specific information during said time interval of specific relevance	Page 552 lines 16-19 with page 541 lines 5-11, page 542 lines 6-9 and page 543 lines 5-9 with, for example page 2 lines 8-19.

p. Claim 34

selecting generally applicable information to be outputted during said time interval of specific relevance	Page 552 line 20 and page 501 lines 21-25 with page 357 lines 22-35. Page 506 line 16 to page 509 line 15 with page 27 lines 21-33.
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q. Claim 35

An interactive method for delivering a modified budget for use with an interactive mass medium program output apparatus, said interactive mass medium programming output apparatus having an input device to receive input from a subscriber, a memory for storing one of a code and a datum, a processor for processing a subscriber reply, a receiver for receiving a signal from a remote station, and a transmitter for communicating information to said remote station, said interactive mass medium output apparatus and said remote station comprising a network having a plurality of transmitter stations, said network	Page 538 line 18
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being capable of <u>one of</u> generating and assembling at least [some] a <u>portion</u> of a budgeting control instruction effective at said interactive mass medium program output apparatus to generate and output a budget modification, the method comprising the steps of:	Page 545 lines 3-28 and page 24 lines 15-21. Page 548 lines 1-6. Page 548 lines 18-22, page 549 line 32 to page 550 line 10, page 555 lines 30-32, and page 556 lines 9-16.
displaying combined medium programming explaining a budget	Page 552 lines 18-30, page 2 lines 18-19.
prompting said subscriber to modify said budget	Page 538 line 18, page 535 line 33, page 508 lines 24-27, and page 555 lines 17-23 with page 550 lines 30-32 and page 551 lines 11-14.
delivering said [modified] budget <u>modification</u> to said interactive mass medium program output apparatus on the basis of said budgeting control instruction	Page 556 lines 9-16 Page 548 lines 1-6

r. Claim 36

wherein said reply executes software, and <u>wherein</u> said one of [a] <u>said</u> code and [a] <u>said</u> datum is part of [a] <u>said</u> budget generated at said interactive mass medium program output apparatus under control of said software, said method further comprising the step of receiving at said interactive mass medium program output apparatus at least one of an instruct signal, said instruct signal containing at least one of said software and said <u>budgeting</u> control instruction.	Page 55 line 27 Page 55 lines 18-23 and page 554 lines 17-19. Page 548 lines 1-6 Page 554 lines 12-16, page 548 lines 18-22 with page 550 lines 30-32.
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s. Claim 37

said reply includes a modification instruction and data to serve as a basis for modifying said budget, said method further comprising the step of processing a variable refined in said network on the basis of said data, said processing occurring at said interactive mass	Page 555 line 17 Page 555 lines 21-22 with page 554 lines 17-19. Page 556 lines 12-16. Page 555 line 30 to page 556 line 11. For example, page 548 lines 18-22, with page 550 lines 10-11.
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medium program output apparatus	
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t. Claim 38

the step of delivering mass medium programming explaining said modified budget[, said delivering being done upon the basis of] <u>based on</u> said budgeting control instruction	Page 552 lines 14-30 with for example, page 552 lines 20-26 and page 491 lines 13-16 or page 492 lines 23-30 with page 493 lines 16-21. For example, page 485 lines 14-18.
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u. Claim 39

selecting generally applicable video, audio or print in accordance with said budgeting control instruction	Page 501 lines 21-25, page 494 lines 4-7, and page 555 line 6 with page 357 lines 22-35 nd page 485 lines 14-18.
outputting said <u>selected</u> generally applicable [information] <u>video, audio, or print.</u>	Page 506 lines 17-21, page 505 line 3, and "\$" at page 496 line 26.

v. Budget

In the paragraph at the bottom of page 14, the Examiner states "regarding the term 'budget', the specification fails to provide an adequate written description of the embodiments claimed in the instant case", and "specification fails to adequately teach the generating of budget data by processing data stored in the computer in response to a control signal."

Applicants respectfully traverse the Examiner and call the Examiner's attention to the passages at page 548, lines 1-6 and 18-22, and especially, page 549 line 32 through page 550 line 11, where the specification states:

35 Then using linear programming techniques that are well known in the art, each farmer's microcomputer, 205, under control of the particular program instruction set generated and transmitted by its local intermediate station, computes

- [bottom of] 549 -

its particular farmer's "optimal" crop planting plan by

5 making reference to said farmer's specific data that
includes, for example, the number and size of the individual
parcels of property of the farmer's farm, the soil conditions
of said parcels, the aspects of said parcels with respect to
sunlight and shade, the history of crop rotation of said
parcels, the farm equipment of said farmer, and the financial
resources of said farmer; by using said data as so-called
"constraints"; and by applying information of said program
10 instruction set. Said information that is applied includes
the specific market price information and ...

(The data of the farmer, to which this passage refers, is also disclosed, for example, at page 534, lines 4-12, and elsewhere.)

"WEBSTER'S New Collegiate Dictionary" (copyrighted 1977 by G. & C. Merriam Co., Springfield, Mass.) defines "linear programming" as " **n** : a mathematical method of solving practical problems (as the allocation of resources) by means of linear functions where the variables involved are subject to constraints."

One example of a textbook treatment of linear programming is provided in *Operations Research for Management Decisions*, Samuel B. Richmond, The Ronald Press Company, New York, 1968. In its preface, this textbook states:

This book is designed to provide an introduction to the study of operations research, a scientific methodology for examining, defining, analyzing, and solving complex problems. (page v) ...

This is an introductory book, and its mathematical requirements are minimal. ... A background of high school algebra will adequately prepare [the reader] to study the full content. (page vi)

This textbook devotes three chapters, totaling eighty-eight pages, to linear programming. At the end of the first of these three chapters, which is twenty-one pages long, the author provides four exercises for the reader. The third exercise deals with an "advertising budget" and its final sentence is, "Solve the problem ... to find the optimal allocation of expenditures ... under

the assumption that all relationships are linear." (page 335) The fourth exercise deals with scheduling work at a manufacturing company, and its final sentence is, "What is the total profit?" (page 335) Applicants cite these exercises provided at the *beginning of an introduction* to linear programming as evidence of their contention that the subject matter of budgeting is *elementary* within this well known and readily available methodology disclosed in the instant Application.

A second textbook, which also devotes several chapters to linear programming, is *Economic Theory and Operations Analysis*, William J. Baumol, Prentice-Hall, Inc., Englewood Cliffs, New Jersey, 1965. This textbook includes a chapter, entitled "Observation on Electronic Computers", in which the author states, "Hundreds of thousands of engineers (and even many economists) have learned *Fortran* which allows them to talk to the machine in formulas ..." page 580.

Other available references, which are cited by these textbooks, include for example:

- Charnes, A., W. W. Cooper, and A. Henderson, *Introduction to Linear Programming*, John Wiley & Sons, Inc., New York, 1953.
- Dantzig, George B., *Linear Programming and Extensions*, Princeton University Press, Princeton, N.J., 1963.
- Dorfman, Robert, Paul A. Samuelson, and Robert M. Solow, *Linear Programming and Economic Analysis*, McGraw-Hill Book Company, New York, 1958.
- Gass, Saul, *Linear Programming, Methods and Applications*, McGraw-Hill Book Company, New York, 1959.

Contrary to the Examiner's contention, Applicants respectfully assert they have disclosed, and fully enabled, "the generating of budget data by processing data stored in the computer in response to a control signal."

The Examiner further states, "the specification fails to adequately teach ... outputting information content explaining the budget datum" (which, in claim 2, now reads "information content explaining a receiver specific budget containing said budget datum") as well as "outputting the budget datum in the time interval (where the time interval is recited in the context

of 'said mass medium programming of a duration, only some of said duration containing *time interval* of specific relevance'), budgeting instruction operative at the interactive video output apparatus to formulate a budget, etc., etc."

Applicants believe that the citations provided above address the Examiner's specific requirements.

In general, it is Applicants' position that the disclosure provided in "Summary Example #11" at page 533 *et seq.* has, as its framework of reference, the full disclosure. Nevertheless, as the Examiner will recognize, in passages such as those at page 545 line 9 and page 552 line 20, Applicants consistently reference pertinent earlier portions of the disclosure. Applicants provide these specific embodiments in support of the pending claims by way of example only. The claims must be read as broadly as is reasonable in light of the specification, and Applicants in no way intend that their submission of excerpts/examples be construed to unnecessarily restrict the scope of the claimed subject matter.

2. Rejections Under 35 U.S.C. §112, Second Paragraph

Claims 2-8, 19-27, 33, and 34 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention.

Regarding claim 2, line 8, "both" has been deleted.

Regarding claim 5, step 3, has been amended to read, "at least."

Regarding claim 19, the Office action questions the meaning of "budgeting instructions."

Applicants believe that the citations provided above address the Examiner's specific requirements.

Regarding claim 20, the Office Action questions the use of "higher language code."

Applicants believe that the citations provided above address the Examiner's specific requirements.

Regarding claims 27, 33, and 34, the Office Action questions the use of the phrase "mass medium programming of a duration including a timer interval of specific relevance." Applicants believe that the citations provided above address the Examiner's specific requirements.

3. Conclusion

Applicants respectfully submit that the claims of the subject application particularly point out and claim the subject matter sufficiently for one of ordinary skill in the art to comprehend the bounds of the claimed invention. The test for definiteness of a claim is whether one skilled in the art would understand the bounds of the patent claim when read in light of the specification, and if the claims so read reasonably apprise those skilled in the art of the scope of the invention, no more is required. *Credle v. Bond*, 25 F.3d 1556, 30 USPQ2d 1911 (Fed. Cir. 1994). The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope. *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994). Applicants have amended the claims to enhance clarity and respectfully submit that all pending claims are fully enabled by the specification and distinctly indicate the metes and bounds of the claimed subject matter.

Applicants believe that the above recited changes are sufficient to overcome the rejections under 35 U.S.C. 112, first and second paragraph, and respectfully request withdrawal of these rejections. Applicants provide these specific embodiments in support of the pending claims by way of example only. The claims must be read as broadly as is reasonable in light of the specification, and Applicants in no way intend that their submission of excerpts/examples be construed to unnecessarily restrict the scope of the claimed subject matter.

E. Response to Rejection of Claims for Absence of Novelty

Applicants further respectfully submit that claim 12 in the present application should be allowed because these methods are not disclosed, taught, suggested, or implied by the applied prior art. For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Foundation v. Genetech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001, 18 USPQ2d 1896 (Fed. Cir. 1991). Absence from a cited reference of any element of a claim negates anticipation of that claim by the reference. *Kloster Speedsteel AB v Crucible, Inc.*, 230 USPQ 81 (Fed. Cir. 1986), *on rehearing*, 231 USPQ 160 (Fed. Cir. 1986).

1. 35 U.S.C. § 102 (b) Rejection over Hedger

Claim 12 stands rejected under 35 U.S.C. § 102 (b) as being anticipated by Hedger.

With respect to claim 12, Hedger fails to teach, *inter alia*, a method of controlling a receiver station including all of Applicants claimed method steps. Hedger, teaches the use of a telesoftware receiver that captures and executes telesoftware programs that are broadcast as pages of information in the disclosed Oracle system. However, Hedger is completely silent as to all of the following: (1) detecting one of the presence and absence of a broadcast or cablecast control signal; (2) inputting a processor interrupt signal to a processor based upon said step of detecting; (3) controlling said processor to output specific information in response to said step of inputting; and (4) generating and outputting user specific budget data on the basis of information received from said processor.

For example, Hedger goes into great detail about the components of the broadcaster system as well as the types of programs to be broadcast and the outcome of such broadcasts.

However, Hedger is completely silent as to the actual workings of the system. There is no suggestion anywhere in Hedger of a broadcast or cablecast control signal or a processor interrupt signal, as claimed by Applicants. Hedger is simply concentrated on what the system may do, not what the system actually does. Therefore, Applicants contend that Hedger fails to suggest or describe Applicants claimed invention, since there is no teaching or suggestion whatsoever of Applicants claimed method steps.

In addition, Applicants contend that the claimed method steps are not inherent, as stated in the Office Action, simply because the prior art may suggest a certain outcome. Applicants further contend that the claimed method steps are clearly not inherent, because Hedger fails to provide any description of how the system works. Withdrawal of the rejection is respectfully requested.

Applicants respectfully submit that the cited art does not anticipate claim 12, since the reference fails to disclose every element of the claimed invention, and Applicants respectfully request that the 35 U.S.C. § 102 (b) rejection of claim 12 be withdrawn.

F. Response to Obviousness Rejection of Claims

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference to combine the teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references combined) must teach or suggest all the claim recitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not based on Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). MPEP 706.02(j).

1. 35 U.S.C. § 103 (a) Rejection over Gunn

Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gunn.

With respect to claim 5, Gunn fails to, *inter alia*, teach or suggest all the claim recitations, i.e., receiving at a transmitter station code which is effective at a receiver station to generate and output user specific budget data. The Office Action equates Gunn's "software supplied via teletext" to Applicants' claimed code. Page 06/09, lines 1-9. Applicants respectfully disagree and submit that the software of Gunn which is downloaded at the user end, is not code that is effective to generate and output user specific budget data. Instead, the software is first downloaded and then used as a tool along with raw data, by the user, in order for the user, to personally analyze a stock portfolio. The software of Gunn is not effective at a receiver station to generate and output user specific budget data. Instead, the user is responsible for generating any analysis. Further, Gunn is completely silent as to outputting the analysis upon completion. Therefore, there is no suggestion whatsoever in Gunn that the software is designed to generate and output user specific budget data.

Further, since there is no teaching in Gunn of code which is effective at a receiver station to generate and output user specific budget data. Then, clearly, there is no suggest of transferring said code from said transmitter station to a transmitter.

In addition, Gunn fails to suggest or describe receiving said at least one control signal at said transmitter station, said at least one control signal is effective at at least one of said plurality of receiver stations to execute said code. The Office Action equates Gunn's teletext signal to Applicants' claimed control signal. Applicants respectfully disagree and submit that the teletext signal of Gunn fails to execute code that functions as Applicants claim. In fact, the teletext signal is only disclosed as activating software provided on cassettes. Not only is this software

different from the software that the Office Action equates as Applicants claimed code, the software is on cassette and fails to function as Applicants claim. Applicants claim that the code is effective at a receiver station to generate and output user specific budget data and that the control signal executes that code. Gunn, on the other hand teaches two separate embodiments: (1) downloadable software to be used in a stock analysis performed by the user; and (2) software on cassette that is activated by the teletext signal. Applicants submit that neither embodiment teaches Applicants claimed invention.

Further, since Gunn is silent as to any code or control signals that function as Applicants claim. Then, Gunn is also silent as to transferring said at least one control signal from said transmitter station to said transmitter, and transmitting an information transmission containing said code and said at least one control signal.

Claim 6-8 depend upon independent claim 5. As discussed *supra*, Gunn fails to disclose every element of claim 5 and thus, *ipso facto*, Gunn fails to anticipate dependent claims 6-8, and therefore, this rejection should be withdrawn and the claim be permitted to issue. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Applicants respectfully request that the 35 U.S.C. §103(a) rejection of claims 5-8 be withdrawn

2. Claims Not Rejected over the Prior Art of Record

Claims 1-4, 9-11, 13-15, and 17-39 are not rejected over the art of record. Applicants respectfully assume that the claims will be allowable once the 112, first and second paragraph rejections have been overcome.

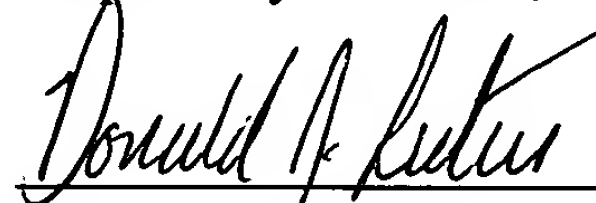
III. CONCLUSION

In accordance with the foregoing it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. Further, all pending claims are patentably distinguishable over the prior art of record, taken in any proper combination. Thus, there being no further outstanding objections or rejections, the application is submitted as being in a condition for allowance, which action is earnestly solicited.

If the Examiner has any remaining informalities to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such informalities.

Date: July 22, 1998
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